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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/866,279	05/30/1997	SUSAN M. DYMECKI	234805	9567

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EXAMINER

FALK, ANNE MARIE

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 07/24/2003

41

Please find below and/or attached an Office communication concerning this application or proceeding.

File

Advisory Action

Application No.

08/866,279

Applicant(s)

DYMECKI, SUSAN M.

Examiner

Anne-Marie Falk, Ph.D.

Art Unit

1632

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 6/25/03 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof. (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☐ The proposed amendment(s) will not be entered because:
 (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1, 52, 55-59 and 62-65.

Claim(s) objected to: _____

Claim(s) rejected: 2-21, 50 and 51.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
 10. ☐ Other: _____

Anne-Marie Falk
 Anne-Marie Falk, Ph.D.
 Primary Examiner
 Art Unit: 1632

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Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejections of Claims 51, 52, 55-57, 59, and 62-65 under 35 U.S.C. 112, second paragraph.

Continuation of 5. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

With regard to Claims 2-21, 50, and 51, the specification fails to provide an enabling disclosure for the full scope of the claims because the phenotype of a transgenic mouse is unpredictable for reasons of record advanced on pages 2-6 of the Office Action of Paper No. 22 (mailed 10/25/00), on pages 2-8 of Paper No. 26 (mailed 7/18/01), and on pages 2-3 of the Office Action of Paper No. 33 (mailed 6/5/02). Thus, the specification fails to teach how to use the full scope of the claimed transgenic mice. In the absence of disclosure of a transgene-dependent phenotypic alteration, one skilled in the art would not know how to use the claimed transgenic mice over the full scope. Thus, one skilled in the art would have been required to engage in undue experimentation in order to make and use the claimed transgenic mice over the full scope.

Therefore, the rejection of Claims 2-21, 50, and 51 under 35 U.S.C. 112, first paragraph, is maintained for reasons of record.